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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,258	06/13/2001	Jane Sheetz	13977 (IND-039)	5090

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EXAMINER

LUONG, SHIAN TINH NHAN

ART UNIT PAPER NUMBER

3728

DATE MAILED: 10/14/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/880,258	<b>Applicant(s)</b> Sheetz et al	
	<b>Examiner</b> Shian T Luong	<b>Art Unit</b> 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 September 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 10, 11, 20, 28 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 12-19, 21-27 and 30 is/are rejected.
- 7) ☒ Claim(s) 31-34 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- |   |  |
|---|--|
| 15) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 20) <input type="checkbox"/> Other: _____                                    |

***Claim Rejections - 35 USC § 112***

1. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, the phrase "coil by by engaging the fiberoptic" appears to be an error.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, 4-5, 9, 12 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Thyen et al. (US 4,424,898). Thyen et al. discloses a package comprising an outer package 23,24, and a carrier 17 with a plurality of parallel retainers 13. The retainers on the opposite ends of reference element 13 are considered the connector end retainer and treatment end retainer or distal tip and connector handle. It is clear from the drawing that selected portion of the retained article may be removed while the other portions remain within the retainers.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 3 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Thyen et al. in view of Cerwin et al. (US 5,833,055). It is not clear whether the package of Thyen et al as shown in Figure 1 is sterilizable. However, Cerwin et al teaches a sterilizable cover 128 made out of foil for a medical package. It would appear that the foil utilize in Thyen et al. would be able to function in the same manner for sterilization purpose.

6. Claims 6, 8 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Thyen et al. in view of Bierman (US 5,354,282). Although Thyen et al. does not show an attachment means to attach the carrier to a surface, Bierman shows, an an example, a carrier with adhesive on a bottom surface to attach the carrier to a desired location. The adhesive is initially secured to a backing prior to usage. It would have been obvious in view of Bierman to provide adhesive on the bottom portion of the carrier to attach the carrier to a surgical table to prevent unnecessary movement.

7. Claims 6-7 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Thyen et al. in view of Official Notice. Although Thyen et al. does not show a spring clip, it is conventional to use a spring clip to attach a receptacle to a surface. It would have been obvious to provide the spring clip on the carrier of Thyen et al. to attach the carrier to a surgical table.

8. Claims 23-27, 30 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art in view of Thyen et al. or Thyen et al in view of Admitted Prior Art. Admitted Prior Art on pages 1-2 teaches that a fiberoptic cable is generally packaged and shipped as a coil. Admitted Prior Art does not disclose a plurality of parallel retainers defining a plurality of recesses. Thyen et al. teaches a package comprising an outer package 23,24, and a carrier 17 with a plurality of parallel retainers. The retainers secure the article until it is removed

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by the user. It would have been obvious to provide retainers on the carrier to secure the article in an organized manner prior to dispensing.

9. Claims 23-24, 26-27, 30 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Thyen et al in view of Admitted Prior Art. Thyen et al. teaches a package comprising an outer package 23,24, and a carrier 17 with a plurality of parallel retainers. The retainers secure the article until it is removed by the user. Admitted Prior Art on pages 1-2 teaches that a fiberoptic cable is generally packaged and shipped as a coil. It would have been obvious to substitute the content of Thyen et al with the fiberoptic cable since it would retain the coil equally well therein.

10. Claim 25 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Thyen et al. in view of Cerwin et al. (US 5,833,055). It is not clear whether the package of Thyen et al as shown in Figure 1 is sterilizable. However, Cerwin et al teaches a sterilizable cover 128 made out of foil for a medical package. It would appear that the foil utilize in Thyen et al. would be able to function in the same manner for sterilization purpose.

#### ***Response to Arguments***

11. Applicant's arguments with respect to claims 1-9, 12, 23-27,30 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Allowable Subject Matter***

12. Claims 13-19, 21-22 would be allowable if rewritten to overcome the rejection(s) under

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35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

13. Claims 31-34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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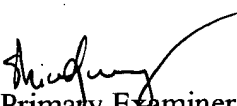
Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners, M.P.E.P. 203.08. The **Group clerical receptionist number is (703) 308-1148** or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Donna Monroe at (703) 308-2209.

For applicant's convenience, the Group Technological Center FAX number is (703) 872-9302 and for After Final Amendment the number is (703) 872-9303. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify Examiner Luong of Art Unit 3728 at the top of your cover sheet of any correspondence submitted.

Inquiries concerning the merits of the examination should be directed to Shian Luong whose telephone number is (703) 308-2039. The examiner can normally be reached on T-F from 7:00am to 4:00pm EST.

STL  
October 13, 2003

  
Primary Examiner  
Shian Luong  
Art Unit 3728